

REMARKS / ARGUMENTS

In response to the Office action dated February 13, 2004 ("OA"), Applicant respectfully requests the Office to enter the following amendments and consider the following remarks. By this response, claims 1-8 and 14-20 have been canceled without prejudice (claims 9-13 were previously withdrawn). With respect to the pending claims, new claims 21-43 have been added. Authorization is hereby given to charge any fees (e.g., extension fees) associated with this response to Deposit Account No. 50-1078.

Applicants submit that the new claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined.

Applicant addresses the new arguments as to the application of the art against Applicant's invention, and respectfully submits the pending claims' allowability, as follows.

Information Disclosure Statement

Regret is expressed that the Information Disclosure Statement references that have now been submitted by Applicants twice have not made it into the USPTO's electronic record system, and submits herewith a CD-ROM containing copies of the cited documents as well as the stamped, returned postcard from the USPTO which indicates that the previous resubmission of these materials was received by the PTO on December 23, 2003. Moreover, in the event that the materials are misplaced a third time, Applicants hereby note that 6 of the 7 cited references are as follows: U.S. Patent Nos. 5,628,961, 5,919,711, 5,971,951 and 6,071,294, and U.S. Patent Application Publication Nos. 2003-0072647A1 and 2003-0073229A1 (which correspond to the "as-filed" patent applications that were previously submitted); the Examiner should be able to review these references even without any actual submission of references by the Applicants.

Claim Interpretation

The claims referred to by the Examiner in its paragraph entitled "Claim Interpretation" on page 2 of the Office action have been canceled without prejudice. In addition to taking the position that the Office's assertion is incorrect, Applicants respectfully submit that the Examiner's statements, in that they pertain to the "*claimed* cartridges" (i.e., they assert a structural allegation specific to the now-canceled claims), are moot, and do not warrant further discussion.

Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-8 and 14-20 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,856,174 to Lipshutz. See OA, page 2 ¶ 3.

Claims 1-8, 14-17, 19 and 20 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,296,378 to Sakata. See OA, page 4 ¶ 4.

Claims 1-8, 14, 15 and 18-20 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,126,804 to Andresen. See OA, page 4 ¶ 4.

Claims 1-8 and 14-20 have been canceled without prejudice, and Applicant submits that the above rejections are thereby rendered moot.

Moreover, Applicants respectfully submit that the new claims adequately clarify the invention so as to define over all of the art of record in this application. Independent claim 21, from which all of the other claims are also dependent, recites a companion cartridge comprised of a base element, an entry port, a fluid reservoir and an operator. Furthermore, claim 21 recites that the base element is "configured to be inserted into an instrument in relation to an associated sensing cartridge that is designed to perform an analyzing operation on a body fluid," and that the companion cartridge "is shaped so as to interact as a modular subcomponent of a diagnostic instrument." In Lipshutz, the reader device is not a "sensing cartridge that is designed to perform an analyzing operation on a body fluid," nor do the cited portions of Lipshutz teach or suggest a companion cartridge that is both "configured to be inserted into an instrument in relation to an associated sensing cartridge" and "a modular subcomponent of a diagnostic

instrument" (see Lipshutz, col. 26, line 43 - col. 28, line 24). Similarly, in view of the clarification in claim 21, the flow cytometer column of Sakata can not longer be argued to teach or suggest a companion cartridge, nor can the laser detection and photomultiplier tube be said to anticipate a "sensing cartridge that is designed to perform an analyzing operation on a body fluid." Lastly, Andresen's one-piece instrument does not anticipate a companion cartridge "configured to be inserted into an instrument in relation to an associated sensing cartridge" and "shaped [in conjunction with the sensing cartridge] so as to interact as a modular subcomponent of a diagnostic instrument."

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 21-43 in condition for allowance. Again, Applicant submits that the new claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments and/or explained earlier arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance

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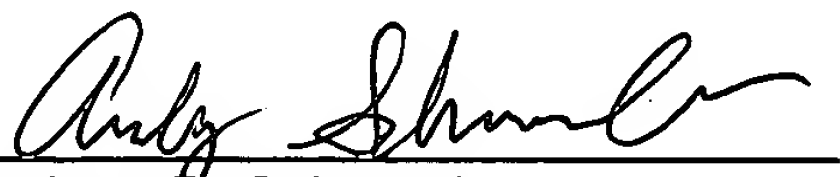
of the pending claims. Furthermore, especially given the application's status in final, the Examiner is urged to contact Andrew B. Schwaab at 650-849-6643¹ if there are any additions/changes Applicant can make to facilitate or expedite allowance of the application.

Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 50-1078.

Respectfully submitted,

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¹ and/or via facsimile as well, at 650-849-6666 (e.g., for advisory actions, etc.).